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## REMARKS

In this application, claims 1-49 are pending. In this Office Action, Examiner Snow made a restriction requirement between two groups of claims, which were characterized as follows:

I. Claims 1-42 and 48-49, drawn to fusion implant, classified in class 623, subclass 17.11.

II. Claims 43-47, drawn to a method of treating adjacent bony structures, classified in class 623, subclass 23.61.

The above language is taken verbatim from the Office Action for the sake of clarity, and is not an admission by Applicants as to the subject matter or classification of any claim.

As the restriction requirement relied on the provisions of 35 U.S.C. § 121, which makes restriction permissive, per the practice noted in MPEP 803 and 808.02 this application should be examined as a whole if it can be done without undue burden on the Examiner. Applicants elect group I (claims 1-42 and 48-49) for prosecution, with traverse on the grounds that searching and examining the entire application can be made without serious burden. Both claim sets include common structural features, such as those of a recited body or implant. In fact, the searching for both sets of claims will likely be identical or at least overlap to a very great extent. Since the searching will overlap and produce references potentially relevant to both sets of claims, there will be no significant extra burden in searching and examining both sets of claims. Per MPEP 803 and 808.02, all pending claims should be examined.

The pending Office Action also indicated that an election of species should be made. The requirement for election of species is also traversed. Examiner Snow indicated his opinion that the present application includes claims directed to the following species:

RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT  
Serial No. 10/669,764  
Attorney Docket: 4002-3424/PC889.00  
Page 2 of 5  
#444656

Species 1 – figures 1-2

Species 2 – figure 3

Species 3 – figures 4-5

Species 4 – figure 6

Species 5 – figure 7

Species 8 – figure 8

The above listing is taken verbatim from the Office Action for the sake of clarity, and is not an admission as to the subject matter or classification of any claim. It is noted that the reference to “Species 8” appears to be a typographical error, and was to read “Species 6”.

To make the objections properly of record, it is respectfully submitted that the election requirement should be withdrawn, principally because a proper *prima facie* case for the requirement has not been established. The sole basis for the requirement was that the alleged species “are independent or distinct because they have patentably distinct and mutually exclusive elements requiring different search techniques.” However, no facts, evidence, reasoning or other basis for that conclusion were given in the Office Action. “The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate.” MPEP 808.01 (emphasis added); see also MPEP 803 (“Examiners must provide reasons and/or examples to support conclusions). No citation to the application, discussion of the embodiments, or other evidence or grounds for that conclusion were provided. Because the MPEP defines a conclusion of restrictability without basis to be inadequate, the requirement should be withdrawn.

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RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT  
Serial No. 10/669,764  
Attorney Docket: 4002-3424/PC889.00  
Page 3 of 5  
#444656

Further, the similarities among the embodiments are such that they can all be efficiently considered together when the claims are searched and examined. If "the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions." MPEP 808.02. The Office Action does not allege that the classification of the alleged species is different, and it seems likely that all such species would be commonly classified. Clearly the same art categories would be consulted for each alleged species, as they all are directed to a fusion implant having a body and a member positioned in the body. It is not apparent from the record that any searching would be necessary for one species "that is not likely to find art pertinent to the other[s]." *Id.* Rather, it is believed that any practical and reasonable search strategy for one species would find references pertinent to all species. Finally, no suggestion was provided that the alleged species would be separately classified or searchable in the future. No patents or other evidence of a separate field of search was provided, as MPEP 808.02 requires. For these additional reasons, the election requirement should be withdrawn.

So as to give a complete response for the sake of efficiency, Species 1 (Figs. 1-2) is provisionally elected, **with traverse**, based at least in part on the believed lack of substantial additional burden in examining all the purported species. It is believed that at least claims 1-6, 10-17, 21-26, 28, 31-36, 41-45 and 47-48 read on Species 1. However, upon the cancellation of claims 43-47 due to the election of claim set 1 above, the claims which the Applicant respectfully asserts read on Species 1 (Figs. 1-2) would include 1-6, 10-17, 21-26, 28, 31-36, 41-42 and 48. Additionally, Examiner Snow stated that the pending claims include no generic claim. Applicants respectfully disagree. There are several claims in the application that are

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RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT

Serial No. 10/669,764

Attorney Docket: 4002-3424/PC889.00

Page 4 of 5

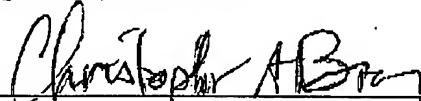
#444656

generic to all of the figures in the application, one of which is claim 26. Applicants reserve the right to claim genericness of other specific pending or added claims later as may be appropriate.

Applicants do not concede the propriety of the request, and do not intend to limit in any way the scope of the claims with the statements or provisional election herein. Specifically, the claims in this application should be given the full scope permitted by their language. Applicants reserve the right to later assert that other claims are generic or read on the provisionally-elected species as well, especially if the election/restriction requirement is not withdrawn. No amendments have been made to the claims, and no new matter has been added. The remarks made herein are not intended to be exhaustive of bases for reconsideration, but simply to effectively and efficiently respond to the pending Office Action. Applicants reserve the right to offer and establish other grounds for reconsideration of this Office Action as may be appropriate.

In conclusion, Applicants have provisionally elected claims 1-42 and 48-49 and Species 1 (Figs. 1-2) of which claims 1-6, 10-17, 21-26, 28, 31-36, 41-45 and 47-48 read on, with traverse, in response to the present election/restriction requirement. It is respectfully requested that the present election/restriction requirement be reconsidered and withdrawn. An Office Action toward a Notice of Allowance in this case is respectfully solicited.

Respectfully submitted,



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RESPONSE TO RESTRICTION AND ELECTION REQUIREMENT  
Serial No. 10/669,764  
Attorney Docket: 4002-3424/PC889.00  
Page 5 of 5  
#444656